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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.	:	7,335,765
Issued	:	February 26,. 2008
Serial No.	:	09/925,673
Applicants	:	Masakatsu KANEKO et al.
Filed	:	August 9, 2001
For	:	NOVEL NUCLEOSIDE AND OLIGONUCLEOTIDE ANALOGUES
Art Unit	:	1623
Examiner	:	Ganapathy KRISHNAN
Docket No.	:	01376CIP/HG
Confirm. No.:		4630
Customer No.:		01933

Express Mail Mailing Label No.: EM 165 824 446 US
Date of Deposit: March 20, 2008
I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 with sufficient postage on the date indicated above and is addressed to:
MAIL STOP PETITION
Commissioner for Patents,
P.O. Box 1450
Alexandria, VA 22313-1450

Dorothy DeFrancesco

Dorothy DéFrancesco

In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by Form PTO-2038 attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper to Account No. 06-1378.

APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

1. This is a request for reconsideration of the patent term adjustment of 225 days indicated in the above-identified issued patent. It is respectfully requested that applicants be afforded a patent term adjustment of 1,067 days (225 days plus 842 days).

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2. This application for patent term adjustment is being filed within two months of the issue date (37 CFR §1.705(d)).

3. Applicants submit herewith a "Statement of the Correct Patent Term Adjustment: Basis Under 37 CFR §1.702 For the Adjustment (37 CFR §1.705(b)(2)(i) and (ii))."

4. The above-identified patent is not subject to a terminal disclaimer (37 CFR §1.705(b)(2)(iii)).

5. As to any circumstances during the prosecution of this patent constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent as set forth in §1.704 (37 CFR §1.705(b)(2)(iv)): there was none (37 CFR §1.705(b)(2)(iv)(B)).

6. The fee set forth in §1.18(e) ($200), required by 37 CFR §1.705(b)(1), is paid as follows:
Attached is a Form PTO-2038 in the amount of $200.

7. Patentees previously filed in the USPTO an APPLICATION FOR PATENT TERM ADJUSTMENT INDICATED IN THE NOTICE OF ALLOWANCE (under 37 CFR 1.705(b)) dated September 6, 2007. The APPLICATION FOR PATENT TERM ADJUSTMENT dated September 6, 2007 was based on 37 CFR 1.702(a)(2) and 35 USC 154(b)(i)(A)(ii), i.e., failure of the USPTO to respond within four months of an applicants' reply under 35 USC 132. The APPLICATION FOR PATENT TERM ADJUSTMENT dated September 6, 2007 was dismissed in a USPTO DECISION dated January 4, 2008. On February 14, 2008, patentees filed a REQUEST FOR RECONSIDERATION in the USPTO of such DECISION.

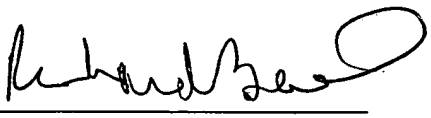
If at the time that this APPLICATION FOR PATENT TERM ADJUSTMENT is taken up, a decision on the February 14, 2008 REQUEST FOR RECONSIDERATION has not yet been decided, patentees respectfully request that a decision on this APPLICATION FOR PATENT TERM ADJUSTMENT and a decision on the REQUEST FOR RECONSIDERATION be issued on the same day.

To the extent not tendered by Form PTO-2038 attached hereto, authorization is given to charge any additional fees to Deposit Account No. 06-1378.

It is respectfully requested that this application for patent term adjustment be granted and that a Certificate of Correction be issued to indicate a patent term adjustment of 1,067 days.

Respectfully submitted,

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Encs.: (1) Statement of the Correct Patent Term Adjustment: Basis Under 37 CFR §1.702 For the Adjustment (37 CFR §1.705(b)(2)(i) and (ii))

(2) Form PTO-2038

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PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : 7,335,765

Issue Date : February 26, 2008

Serial No. : 09/925,673

Applicants : Masakatsu KANEKO et al.

Filed : August 9, 2001

For : NOVEL NUCLEOSIDE AND OLIGONUCLEOTIDE ANALOGUES

Art Unit : 1623

Examiner : Ganapathy KRISHNAN

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STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT: BASIS UNDER 37 CFR §1.702 FOR THE ADJUSTMENT (37 CFR §1.705(b)(2)(i) AND (ii))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

1. This statement is being submitted in support of the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))" to which this statement is attached.

II. 37 CFR §1.705(b)(2)(i)

The patent term adjustment indicated in the above-identified patent is 225 days. It is respectfully submitted that such indication of patent term adjustment is in error.

The aforesaid error is based on the failure of USPTO to account for a USPTO delay of 842 days, which arose from the June 22, 2006 withdrawal from issue on the initiative of the USPTO after the issue fee was paid on June 27, 2005, which resulted in the patent not issuing until February 26, 2008.

It is respectfully submitted that the correct patent term adjustment under 37 CFR §1.702 is 1,067 days, i.e., 225 days plus 842 days.

II. 37 CFR §1.705(b)(2)(ii)

A. The relevant dates on which applicants seek adjustment are as follows:

1. In reply to the Corrected Notice of Allowance and Fee(s) Due mailed April 5, 2005 (which required that the Issue Fee be paid by July 5, 2005), the Issue Fee for the above-identified application was **paid** by a check on June 27, 2005.

2. The USPTO issued a "NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(c) (undated, but mailed on June 22, 2006) (hereinafter referred to as the "NOTICE OF WITHDRAWAL").

The NOTICE OF WITHDRAWAL erroneously stated that the Issue Fee had not been paid. As noted hereinabove, the Issue Fee was paid by check on June 27, 2005.

The NOTICE OF WITHDRAWAL erroneously stated that the withdrawal was under 37 CFR 1.313(c) (i.e., upon petition by applicants). As pointed out in applicants' LETTER RE: NOTICE OF WITHDRAWAL FROM ISSUE filed July 11, 2006, the application was withdrawn from issue by the initiative of the USPTO and therefore was pursuant to 37 CFR 1.313(b), not 37 CFR 1.313(c).

3. An Office Action dated August 1, 2006 rejected claims 2, 4, 5 and 6 under 35 USC 112, second paragraph; and under 35 USC 102 and 35 USC 103, rejected claims 1-7, 37-45, 55, 62-65, 70, 72, 76 and 111 over disclosure in the specification of USP 6,794,499 to Wengel et al.

USP 6,794,499 to Wengel et al. was cited in applicants' INFORMATION DISCLOSURE STATEMENT filed February 17, 2005 (hereinafter referred to as the "February 17, 2005 IDS"). In the February 17, 2005 IDS, it was stated that USP 6,794,499 B2 issued

from application Serial No. 09/152,059, and that US 2002/0068708 A1 (the published application of Serial No. 09/152,059) was cited in applicants' INFORMATION DISCLOSURE STATEMENT filed August 17, 2004. USP 6,794,499 B2 and US 2002/0068708 A1 are hereinafter referred to collectively as "Wengel et al."

Said August 17, 2004 INFORMATION DISCLOSURE STATEMENT also identified USP 6,670,461 B1; US 2003/0134808 A1 and US 2003/0144231 A1, which are patent family members with the aforedescribed Wengel et al. USP 6,794,499 B2 and US 2002/0068708 A1, and all these U.S. patent documents should have the same specification and disclose the same subject matter relied upon in the rejection of claims under 35 USC 102 and 35 USC 103 in the August 1, 2006 Office Action. The Examiner considered and made of record said August 17, 2004 Information Disclosure Statement by returning a fully initialed copy of the August 17, 2004 IDS Form on May 4, 2005.

It is therefore respectfully submitted that the USPTO unduly delayed in for the first time applying the Wengel et al. specification to reject the applicants' claims in the August 1, 2006 Office Action, after the USPTO withdrew the above-identified application from issue more than a year after applicants paid the Issue Fee on June 27, 2005.

An AMENDMENT UNDER 37 CFR 1.111, which (i) made minor editorial corrections to several claims and (ii) which traversed

said rejections under 35 USC 102, 35 USC 103 and 35 USC 112, was filed November 8, 2006.

A FINAL rejection was mailed February 7, 2007, which withdrew the 35 USC 112 rejection and again rejected all of the claims under 35 USC 102 and 35 USC 103 over said Wengel et al. USP 6,794,499.

A RESPONSE UNDER 37 CFR 1.116 was filed May 7, 2007, which did not amend claims, but instead traversed the rejections under 35 USC 102 and 35 USC 103 (the only remaining rejections).

4. A NOTICE OF ALLOWANCE AND FEE(S) DUE was mailed to the USPTO July 26, 2007, along with a Determination of Patent Term Adjustment Under 35 USC 154(b), which indicated a patent term adjustment of 195 days.

5. An Issue Fee Transmittal was mailed to the USPTO on September 27, 2007 (without the payment of the issue fee, since the issue fee was previously paid on June 27, 2005).

6. The patent (USP 7,335,765) issued on February 26, 2008. The front page of USP 7,335,765 indicated that the Patent is extended or adjusted under 35 U.S.C. 154(b) by 225 days.

B. The adjustment sought herein is based on the following:

1. The issue fee was **paid** on June 27, 2005, and the patent did not issue within four months thereof (35 USC 154(b)(i)(iv); 37 CFR 1.702(a)(4));

2. The USPTO withdrew the application from issue on its own initiative on June 27, 2005 to reject claims on a disclosure (Wengel et al.), which was made of record by the patentees as early as August 17, 2004, and the USPTO delayed to issue an Office Action until August 1, 2006;

3. The patent issued on February 26, 2008, which is 872 days after 4 months from the payment of the issue fee on June 27, 2005;

4. The front page of the patent indicated a patent term adjustment of 225 days, which included an additional 30 days of patent term adjustment from that indicated in the Determination of Patent Term Adjustment Under 35 USC 154(b) which was attached to the NOTICE OF ALLOWANCE AND FEE(S) DUE mailed July 26, 2007.

5. The additional 842 days of patent term adjustment requested herein is calculated as follows: 872 days - 30 days.

III. USPTO DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT DATED JANUARY 4, 2008

A. Background

1. An APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR §1.705) (hereinafter referred to as the "September 6, 2007 APPLICATION FOR PTA") was filed in the above-identified application on September 6, 2007. Additional days of patent term adjustment were requested therein based on 37 CFR 1.702(a)(2).

2. In reply to the September 6, 2007 APPLICATION FOR PTA, patentees received a DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT dated January 4, 2008 (hereinafter referred to as "the January 4, 2008 DECISION") in the above-identified application. The January 4, 2008 DECISION dismissed the September 7, 2007 APPLICATION FOR PTA.

On page 2, lines 10 to 11 in the January 4, 2008 DECISION, the following was stated: "First of all, the relevant section to

consider is 37 CFR 1.702(a)(4), not (a)(2)." No reason was given in the January 4, 2008 DECISION why 37 CFR 1.702(a)(2) was not the relevant section. Thereafter, the January 4, 2008 DECISION was made based on 37 CFR 1.702(a)(4).

Patentees did not refer to 37 CFR 1.702(a)(4) in their September 6, 2007 APPLICATION FOR PTA, since at that time it was considered that it was premature to rely on 37 CFR 1.702(a)(4) because a patent had not yet issued.

3. Since the January 4, 2008 DECISION was decided on the basis of 37 CFR 1.702(a)(4), to avoid any possible estoppel, in the REQUEST FOR RECONSIDERATION OF DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT filed February 14, 2008, the patentees asserted 37 CFR 1.702(a)(4) (and 35 USC 154(b)(i)(A)(iv)), in addition to 37 CFR 1.702(a)(2), as an alternate basis for requesting additional days of patent term adjustment.

This APPLICATION FOR PATENT TERM ADJUSTMENT supersedes the assertions under 37 CFR 1.702(a)((4) set forth in the REQUEST FOR RECONSIDERATION OF DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT filed February 14, 2008.

B. Rebuttal of The Reason For Dismissal Stated In the January 4, 2008 DECISION

35 USC 159(b)(i)(A)(iv) refers to delays, due to the failure of the Patent and Trademark Office to

> "(iv) issue a patent within 4 months after the date on which the Issue Fee was **paid** under section 151 and all outstanding requirements were satisfied." (emphasis added)

At the bottom of page 2 of the January 4, 2008 DECISION, the following was quoted from 65 Fed. Reg. 54366 dated September 18, 2000:

> "the date the issue fee was paid and all outstanding requirements were satisfied is the later date of the date the issue fee was paid or the date all outstanding requirements were satisfied. However, if prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308)."

It is respectfully submitted that the above quote represents only a comment in an OG Notice and is not supported by a statute, a PTO rule, a cited precedent or a MPEP provision. Moreover, such quoted passage does not distinguish between a withdrawal from issue on the initiative of the USPTO (as in the case at

hand) or a withdrawal from issue based on an applicant's petition. It is therefore respectfully submitted that the above quote is not relevant with respect to the case at hand.

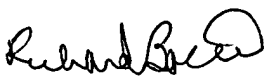
Applicants respectfully disagree with the contention in the first sentence on page 3 of the January 4, 2008 DECISION that "the date of payment of the issue fee on June 27, 2005 is not controlling." As discussed above, the withdrawal from issue on June 22, 2006 was at the initiative of the USPTO. It is respectfully submitted that the start of the USPTO delay under 37 CFR 1.702(a)(4) should be determined based on the payment of the Issue Fee on June 27, 2005, and not when a subsequent Issue Fee transmittal was submitted on September 27, 2007 (wherein the issue fee was not paid).

It is emphasized that 35 USC 159(b)(i)(A)(iv) refers to payment of the issue fee.

IV. Conclusion

Reconsideration and the granting of the additional days of patent term adjustment as requested herein are respectfully requested.

Respectfully submitted,



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